

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this petition is being transmitted electronically via the United States Patent and Trademark Office's Electronic Filing Service (EFS-Web) on this 2nd day of January, 2008.



Debra L. Hale

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:)	Examiner:	
Cubukcu et al.)	Alejandro, Raymond	
)		
Serial No.: 10/612,230)	Art Unit:	1745
)		
Filed: July 2, 2003)	Docket No.:	21980-04012
)		
For: Ceramic Composite)	Confirmation No.:	3819
Electrolytic Device and)		
Method)		
)		

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER C.F.R. §1.181 TO WAIVE
REQUIREMENT FOR NEW DECLARATION**

Dear Sir:

Applicants respectfully request the Commissioner to waive the requirement for a new declaration, as set forth in Paragraph 3 of the Final Office Action of October 2, 2007. In particular, Applicants respectfully request the Commissioner to determine that the Rule 63 declaration previously filed in this case satisfies all requirements of Rule 63(a)(4), 37 C.F.R. §1.63(a)(4), as well as 35 U.S.C. §115, even though it fails to expressly state that the inventors are the "original" inventors.

This application is a division of USSN 09/592,190, filed June 12, 2000, which in turn is a division of USSN No. 09/020,204, filed February 6, 1998. Accordingly, the Rule 63 declaration

in this case is the original Rule 63 declaration filed in grandparent application USSN No. 09/020,204 filed January 4, 1999. A copy of this declaration, as appearing in the files of the undersigned, which is believed to be a true copy of this declaration, is attached as Exhibit 1.

This declaration has already been reviewed by the Office of Petitions twice and not found wanting. In this regard, attached as Exhibit 2 is a copy of a petition under 37 C.F.R. §1.47(b) filed in the grandparent application on November 2, 1998. Attached as Exhibit 3 is a copy of the decision of October 8, 1999, granting this petition. Attached as Exhibit 4 is a copy of the decision of March 12, 2004, granting applicants' petition to accept the current application under 37 C.F.R. §1.47(b).

During prosecution of this application, the examiner noticed that this original Rule 63 declaration filed January 4, 1999, fails to state, expressly, that the inventors are "original" inventors, as required by 35 U.S.C. §115 and 37 C.F.R. §1.63(a)(4). In this regard, note that in the operative sentence of this declaration, found immediately before the emboldened title of the application, applicants state they are the "first and joint" inventors without also expressly stating that they are "original" inventors as well.

Applicants believe that, in the context of 35 U.S.C. §115 and 37 C.F.R. §1.63(a)(4), the statement that an individual is "a first inventor" subsumes the statement that the individual is the "original inventor," because it is metaphysically impossible for an individual to be a "first inventor" without also being an "original inventor."

In this regard, Webster's Ninth New Collegiate Dictionary, © 1985, Merriam-Webster, Inc., defines "first" as meaning "preceding all others in time... **a:** EARLIEST." That being the case, a person who asserts himself/herself to be a "first" inventor is, necessarily inherently, also asserting himself/herself to be is an "original" inventor because, by definition, he/she could not have derived the claimed subject matter from someone else, since it had not been invented yet, *i.e.*, it had not been invented earlier.

Note, in this regard, that the inverse is not true. That is, an individual can be an original inventor without also being the first inventor. That is why both 35 U.S.C. §115 and 37 C.F.R. §1.63(a)(4) require inventors to declare themselves to be "first" as well as "original" inventors. However, where an inventor has already declared himself/herself to be a "first" inventor, he/she

has also necessarily declared himself/herself to be an "original" inventor, since he/she could not have derived the invention from someone else, by definition.


Accordingly, applicants believe their previous, express statements that they are the "first" inventors satisfies the requirements of both 35 U.S.C. §115 and 37 C.F.R. §1.63(a)(4) that they also declare themselves to be the "original" inventors, because by definition they cannot be "first" inventors without also being "original" inventors.

Accordingly, applicants respectfully request the commissioner to determine that the Rule 63 declaration previously filed in this case satisfies all requirements of Rule 63(a)(4), 37 C.F.R. §1.63(a)(4), as well as 35 U.S.C. §115, and therefore to waive the requirement for a new declaration, as set forth in Paragraph 3 of the Final Office Action of October 2, 2007.

If any additional fee is due with this petition, please charge our deposit account no. 03-0172.

Respectfully Submitted,

Date: 1/2/08



John E. Miller, Reg. No. 26,206
Calfee, Halter & Griswold LLP
Customer No. 24024
Phone: 216-622-8200

CALFEE, HALTER & GRISWOLD

Docket No. 21980/04001

DECLARATION
AND POWER OF ATTORNEY

ORIGINAL APPLICATION

As below named inventors, we hereby declare that:

Our residence, post office address and citizenship are as stated below next to our names.

We believe we are the first and joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**CERAMIC COMPOSITE ELECTROLYTIC DEVICE AND METHODS FOR
MANUFACTURE THEREOF**

the specification of which

- ☒ is attached hereto,
- ☒ was filed on February 6, 1998
- ☒ as Application Serial No. 09/020204
- ☐ and was amended on _____
(if applicable)

We hereby state that we have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56.

We hereby appoint the following attorney(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Charles B. Lyon
Reg. No. 25,739

William N. Hogg
Reg. No. 20,156

Jeanne E. Longmuir
Reg. No. 33,133

Tara A. Kastelic
Reg. No. 35,980

Exh. 1

Mary E. Golrick
Reg. No. 34,829

Carmen R. Adams
Reg. No. 38,809

June E. Rickey
Reg. No. 40,144

Leonard L. Lewis
Reg. No. 31,176

James A. Rich
Reg. No. 25,591

John T. Wiedemann
Reg. No. 28,920

James C. Scott
Reg. No. 35,351

Sean T. Moorhead
Reg. No. 38,564

Address all telephone calls to Jeanne E. Longmuir at telephone no. (216) 622-8200.

Address all correspondence to Jeanne E. Longmuir, Calfee, Halter & Griswold, LLP 800 Superior Avenue, Suite 1400 Cleveland, Ohio 44114-2688.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole
or first inventor

Esin Cubukcu

Inventor's
Signature

Date

Residence

9725 Weathertop Lane
Auburn, Ohio 44023

Citizenship

Turkey

Post Office Address

9725 Weathertop Lane
Auburn, Ohio 44023

Full name of
second inventor

Steve Dahar

Inventor's
Signature

Steve Dahar

9/30/28
Date

Residence

7060 Longview
Solon, Ohio 44139

Citizenship

USA

Post Office Address

7060 Longview
Solon, Ohio 44139

Full name of
third inventor

Ravi Dodeja

Inventor's
Signature

Date

Residence

5231 Austen Lane
Richmond Heights, Ohio 44143

Citizenship

USA.

Post Office Address

5231 Austen Lane
Richmond Heights, Ohio 44143

Full name of
second inventor

Steve Dahar

Inventor's
Signature

Date

Residence

7060 Longview
Solon, Ohio 44139

Citizenship

USA

Post Office Address

7060 Longview
Solon, Ohio 44139

Full name of
third inventor

Ravi Dodeja

Inventor's
Signature

R - S -

6/10/98
Date

Residence

5231 Austen Lane
Richmond Heights, Ohio 44143

Citizenship

USA.

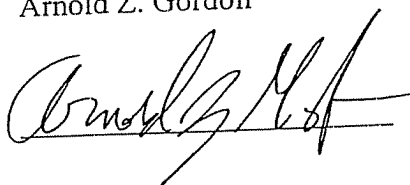
Post Office Address

5231 Austen Lane
Richmond Heights, Ohio 44143

Full name of
fourth inventor

Arnold Z. Gordon

Inventor's
Signature



6/8/98
Date

Residence

23714 Woodway
Beachwood, Ohio 44122

Citizenship

USA

Post Office Address

23714 Woodway
Beachwood, Ohio 44122

Full name of
fifth inventor

Daniel Kalynchuk

Inventor's
Signature

Date

Residence

2431 Saybrook Road
University Heights, Ohio 44118

Citizenship

USA

Post Office Address

2431 Saybrook Road
University Heights, Ohio 44118

Full name of
fourth inventor

Arnold Z. Gordon

Inventor's
Signature

Date

Residence

23714 Woodway
Beachwood, Ohio 44122

Citizenship

USA

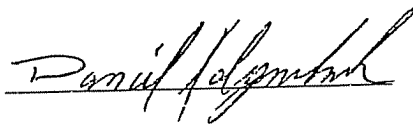
Post Office Address

23714 Woodway
Beachwood, Ohio 44122

Full name of
fifth inventor

Daniel Kalynchuk

Inventor's
Signature



June 11, 1998
Date

Residence

2431 Saybrook Road
University Heights, Ohio 44118

Citizenship

USA

Post Office Address

2431 Saybrook Road
University Heights, Ohio 44118

Full name of
sixth inventor

Troy Shannon Prince

Inventor's
Signature

Date

Residence

4987 Hollyview Drive
Vermilion, Ohio 44089

Citizenship

USA

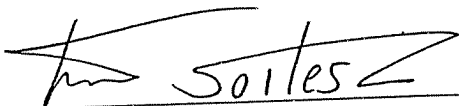
Post Office Address

24987 Hollyview Drive
Vermilion, Ohio 44089

Full name of
seventh inventor

Justin Soltesz

Inventor's
Signature



6/10/98
Date

✕

Residence

7313 Beach Road
Wadsworth, Ohio 44281

Citizenship

USA

Post Office Address

7313 Beach Road
Wadsworth, Ohio 44281

Full name of
eight inventor

Mike Waite

Inventor's
Signature

Michael Waite

8-28-98

Date

Residence

20749 Parkwood Lane
Strongsville, Ohio 44136

Citizenship

USA

Post Office Address

20749 Parkwood Lane
Strongsville, Ohio 44136

Full name of
ninth inventor

Sandeep Chawla

Inventor's
Signature

Date

Residence

23351 Chagrin Blvd. #304
Beachwood, Ohio 44122

Citizenship

Indian

Post Office Address

23351 Chagrin Blvd. #304
Beachwood, Ohio 44122

Full name of
eight inventor

Mike Waite

Inventor's
Signature

Date

Residence

20749 Parkwood Lane
Strongsville, Ohio 44136

Citizenship

USA


Post Office Address

20749 Parkwood Lane
Strongsville, Ohio 44136

Full name of
ninth inventor

Sandeep Chawla

Inventor's
Signature



08/27/98
Date

Residence

23351 Chagrin Blvd. #304
Beachwood, Ohio 44122

Citizenship

Indian

Post Office Address

23351 Chagrin Blvd. #304
Beachwood, Ohio 44122

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of :
Cubukcu, et al. : Group Art Unit:
Serial No.: 09/020,204 :
Filed: 2/6/98 : Examiner:
For: Ceramic Composite Electrolytic :
Device and Methods for Manufacture: :
Thereof :
Attorney Docket: 21980/04001 :

Assistant Commissioner of Patents
Washington, D.C. 20231

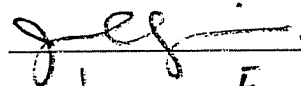
PETITION PURSUANT TO 37 C.F.R. § 1.47(b)

Applicant, IGR Enterprises, Inc. (herein "IGR") hereby petitions the Commissioner to make it the agent for, or to permit it to file on behalf of, two of the joint inventors in the above-mentioned application, Ser. No. 09/020,204: Esin Cubukcu and Troy S. Prince. IGR further requests that title to the application and all related patents issuing therefrom be granted in the name of, and to, IGR. IGR believes this petition should be granted, since it has obtained the written agreement of these inventors that their inventions shall be the exclusive property of IGR, and that they will execute any patent applications to perfect IGR's rights. As a result, IGR has a sufficient proprietary interest in the subject patent application to prosecute this application and be awarded title to the patents resulting therefrom, and the grant of this petition is necessary in order to preserve IGR's rights in the above-mentioned patent application. Additional facts and

CERTIFICATE OF MAILING (37 CFR 1.8A)

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner of Patents, Washington, D.C. 20231.

Date: 11/2/98


Jeanne E. Longmire
(Signature of person mailing paper)

Exh. 2

circumstances surrounding the diligent efforts taken to obtain the signatures of these inventors are set forth below.

IGR is a small research and development corporation, which employs approximately 8-12 part and/or full time individuals. In December, 1997, a patent application was filed by IGR related to its proprietary oxygen generation system (the "oxygen application"). This application named eight (8) inventors and was filed without signature. At the time of the filing, five (5) of the eight (8) inventors were currently employed by IGR. In early February, 1998, the present application (the "SOFC application") was filed naming nine (9) inventors, eight of whom are the same as the inventors in the oxygen application. At the time of the filing of the SOFC application, six (6) of the nine (9) inventors were currently employed by IGR.

In late February, 1998, following receipt of the Notice of Missing Parts containing the application serial number, the necessary declarations were forwarded to the named inventors in the oxygen application. During the process of attempting to obtain the signatures of the oxygen application inventors, two of the former IGR employee inventors initially orally indicated that they were not inclined to execute this application. Both of these objecting inventors were former employees of IGR. After several conversations with both of these objecting inventors, Steve Dahar and Mike Waite, these inventors fulfilled their obligation to IGR and executed the requested declarations in late August, 1998. There were no other objections from the remaining inventors, all five of whom agreed to execute the declaration, and in all cases but one, that of inventor Mr. Troy Prince, did so promptly. With respect to Mr. Prince, a former IGR employee, he delivered his declaration and assignment by hand to IGR at the very end of the time for filing of the missing parts.

During the period of time in which signatures were being obtained for the oxygen application declaration, the Notice of Missing Parts was received in connection with this SOFC application; on or about May 7, 1998. The declarations and assignments for the SOFC application were forwarded to the current IGR employee inventors: Gordon, Soltesz, Dodeja and Chawla, and these declarations were executed and are being filed. Likewise, a declaration and assignment were requested of former IGR employee inventor Kalynchuk, which were executed and are being filed. Once the signatures of the two objecting inventors were obtained in the

oxygen application, additional declarations and assignments for the SOFC application were forwarded and executed by Messrs. Dahar and Waite.

At that same time, correspondence was forwarded to Mrs. Esin Cubukcu, now a former IGR employee, at what is believed to be her current home address: 9725 Weathertop Lane, Auburn, Ohio 44023. A copy of the correspondence is attached. Mrs. Cubukcu was earlier informed by the undersigned at the time the declaration for the oxygen application was being obtained, that the SOFC application would be forwarded to her attention. Indeed it is believed that a copy of the application was previously provided to her. She had previously reviewed the application at the time of its filing. The address used to correspond with Mrs. Cubukcu concerning the SOFC application is the same address which was recently used to successfully correspond with this inventor concerning the oxygen application. No response has been received.

Turning again to Mr. Prince, it was known that the address used for his mailing and for inventorship is his "permanent address": 4987 Hollyview Drive, Vermilion, Ohio 44089. Mr. Prince is, or was until fairly recently, a college student, and uses his parent's address as his permanent address. In light of the oxygen application experience, although there was confidence that the application materials would reach Mr. Prince at his permanent address, it was preferred to attempt to locate him more quickly at his school address using contacts within IGR. Attempts made by one of the other inventors to contact Mr. Prince electronically and via telephone which are normally, and had just previously been, successful in connection with the oxygen application, were unsuccessful. Likewise, the undersigned attempted to reach Mr. Prince or his parent's via telephone at the current address, but was unsuccessful. With little time remaining, the materials were forwarded to the permanent address via courier. A copy of the correspondence is attached.

With regard to the two inventors who have not been reached, it is believed that the requested executed declarations will eventually be provided. This is especially true in light of their prior communications concerning the oxygen application. These were not the inventors who indicated any reluctance to execute documents requested by IGR. It is believed that these inventors understand their legal obligation to execute the requested documents. A copy of the Confidentiality and Assignment Agreement executed by all IGR employees is attached. In the

event that the copies of this agreement as signed by inventors Cubukcu and Price are required, copies will be provided.

In view of the foregoing, 37 C.F.R. 1.47(b) applicant IGR respectfully requests that the present application be allowed by applicant IGR as it is the rightful owner of the subject matter of these applications, and the action is necessary to preserve IGR's rights in this application. In the event there are questions concerning this petition, or additional information can be provided, please contact the undersigned.

The Commissioner is hereby authorized to charge Deposit Account No. 03-0172 the petition fee of \$130.00 which is believed due. In the event additional fees are required in connection with this petition or the maintenance of this application, please consider this authorization to charge such fees.

Respectfully submitted,



Jeanne Longmuir
Reg. No. 33,133
Calfee, Halter & Griswold LLP
800 Superior Ave., Suite 1400
Cleveland, Ohio 44114
Attorney for Applicant IGR Enterprises, Inc.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JEANNE E LONGMUIR
CALFEE HALTER & GRISWOLD
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114-2688

COPY MAILED

RECEIVED
OCT 14 1999

OCT 08 1999

In re Application of :
Cubukcu, Dahar, Dodeja, :
Gordon, Kalynchuk, Prince, : SPECIAL PROGRAMS OFFICE
Soltesz, Waite and Chawla : DECISION ACCORDING STATUS
Application No. 09/020,204 : UNDER 37 CFR 1.47(a)
Filed: February 6, 1998 :
For: CERAMIC COMPOSITE :
ELECTROLYTIC DEVICE AND METHOD :
FOR MANUFACTURE THEREOF :

This is in response to the petition Under 37 CFR 1.47(a),
filed November 5, 1998, and to the declaration filed
January 4, 1999.

The petition is granted.

Petitioner has shown that the non-signing inventor Prince has
been presented with the application papers and has been asked
to sign the declaration for the application. It is
reasonable to conclude from his failure to reply that he has
refused to join in the filing of the above-identified
application.

The above-identified application and papers have been
reviewed and found in compliance with 37 CFR 1.47(a). This
application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(a), this Office will forward notice
of this application's filing to the non-signing inventor at
the address given in the Declaration. Notice of the filing
of this application will also be published in the Official
Gazette.

After this decision is mailed, the above-identified
application will be forwarded to Group Art Unit 1741.

Telephone inquiries regarding this decision should be
directed to the undersigned at (703)306-3159.

Karin Tyson

Karin Tyson
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Exh. 3

21980/10001



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

Troy Shannon Prince
4987 Hollyview Drive
Vermilion OH 44089

In re Application of
Cubukcu, Dahar, Dodeja, Gordon, Kalynchuk, Prince, Soltesz,
Waite and Chawla
Application No. 09/020,204
Filed: February 6, 1998
For: CERAMIC COMPOSITE ELECTROLYTIC DEVICE AND METHOD FOR
MANUFACTURE THEREOF

Dear Mr. Prince:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703)305-9285. Requests for information regarding your application should be directed to the File Information Unit at (703)308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703)308-9726 or 1(800)972-6382 (outside the Washington D.C. area).

Karin Tyson
Karin Tyson
Senior Legal Advisor/Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

JEAN M MACHELEDT
MACHELEDT BALES & JOHNSON
501 SKYSAIL LANE
SUITE 100
FORT COLLINS, CO 80525-3133



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA VA 22313-1450
WWW.USPTO.GOV

Paper No. None

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND OH 44114

COPY MAILED

MAR 12 2004

OFFICE OF PETITIONS

In re Application of :
Esin Cubukcu, Steve Dahar, Ravi Dodeja, :
Arnold Z. Gordon, Daniel Kalynchuk, Troy :
Shanon Prince, Justin Soltesz, Mike Waite, :
and Sandeep Chawla :
Application No. 10/612,330 :
Filed: July 2, 2003 :
Attorney Docket No. 21980-04012 :
Title: CERAMIC COMPOSITE :
ELECTROLYTIC DEVICE :

DECISION ON PETITION

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed November 21, 2003.

On July 2, 2003, the application was deposited, identifying Esin Cubukcu, Steve Dahar, Ravi Dodeja, Arnold Z. Gordon, Daniel Kalynchuk, Troy Shanon Prince, Justin Soltesz, Mike Waite, and Sandeep Chawla as joint inventors. The application was deposited without a fully executed oath or declaration². On September 30, 2003, the Office mailed a Notice to File Missing Parts of Nonprovisional Application (Notice), requiring an executed oath or declaration along with the surcharge associated with the late filing of an

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligence
- (5) a declaration which complies with 37 CFR §1.63.

² Joint inventor Prince did not execute the declaration.

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MAR 30 2004

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Exh. 4

oath or declaration. The notice set a two-month period for response, and indicated that the basic filing fee and replacement drawings were required.

The instant application is a divisional of parent application 09/020,204, which issued as patent number 6074771 on June 13, 2000. On November 5, 1998, petitioner filed a petition under 37 C.F.R. §1.47(a) to accept the declaration without the signature of joint inventor Prince. On October 8, 1999, a decision was mailed which accorded Rule 47(a) status to application number 09/020,204.

On November 21, petitioner submitted a copy of the declaration³, the instant petition, a statement of facts, the basic filing fee, the petition fee (charged to Petitioner's Deposit Account, as authorized in the petition), a copy of the 1.47(a) petition filed with the parent application (09/020,204), copies of letters and an assignment agreement, and a copy of the decision mailed October 8, 1999.

On December 22, 2003, the Office withdrew the notice mailed September 30, 2003, and mailed a corrected notice, which set forth that all signatures were missing from the declaration, and that substitute drawings were required. The corrected notice restarted the two-month period for response.

Petitioner should note that although she filed a petition under 37 CFR §1.47(a) on November 21, 2003, she was not relieved of the requirement to submit a timely reply to the Notice to File Missing Parts of Application⁴. Both the notice and the corrected notice set forth that substitute drawings were required. To date, these have not been supplied.

37 C.F.R. 1.63(d)(3) sets forth:

- (3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under 37 C.F. R. §1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:
- (i) A copy of the decision granting a petition to accord 37 C.F. R. §1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under 37 C.F. R. §1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. §§120, 121, or 365(c); and
 - (ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. §§120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

MPEP 201.06(c) sets forth:

37 CFR 1.63(d)(3) provides for the situation in which the executed oath or declaration, of which a copy is submitted for a continuation or divisional application, was originally filed in a prior application accorded status under 37 CFR 1.47. 37 CFR 1.63(d)(3)(i) requires a copy of any decision granting a petition to accord 37 CFR 1.47 status to such application, unless all nonsigning inventor(s) or legal representative

³ Again, the declaration submitted with the instant petition was executed by each of the joint inventors save joint inventor Prince.

⁴ See 37 CFR §1 135(b).

(pursuant to 37 CFR 1.42 or 1.43) have filed an oath or declaration to join in an application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c). Where one or more, but not all, nonsigning inventor or legal representative (pursuant to 37 CFR 1.42 or 1.43) subsequently joins in any application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c), 37 CFR 1.63(d)(3)(ii) also requires a copy of any oath or declaration filed by the inventor or legal representative who subsequently joined in such application.

New continuation or divisional applications filed under 37 CFR 1.53(b) which contain a copy of an oath or declaration that is not signed by one of the inventors and a copy of the decision according 37 CFR 1.47 status in the prior application, should be forwarded by the Office of Initial Patent Examination (OIPE) to the Office of Petitions before being forwarded to the Technology Center (TC). The Office of Petitions will mail applicant a letter stating that "Rule 47" status has been accorded to the continuation or divisional application, but will not repeat the notice to the nonsigning inventor nor the announcement in the *Official Gazette*. See 37 CFR 1.47(c).

Petitioner has supplied copies of both the petition of November 5, 1998 and the decision of October 8, 1999.

As such, The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

The petition is **GRANTED**.

As provided in MPEP 204.06(c), this Office will not forward notice of this application's filing to the non-signing inventor at the addresses given in the petition, and notice of the filing of this application will not be repeated in the Official Gazette.

After this decision is mailed, the application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
Attorney
Office of Petitions
United States Patent and Trademark Office